

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

CHARD, Joshua T., et al.)	
)	
Serial No.: 10/664,622)	Docket No.: 32340-DIV
)	
Filed: September 17, 2003)	Group Art Unit No.: 3634
)	
Title:)	Examiner: CHIN SHUE, Alvin
)	
ISOLATION MECHANISM FOR)	
ELECTRICALLY ISOLATING)	
CONTROLS OF A BOOMED)	
APPARATUS)	

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

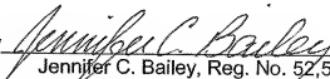
APPELLANTS' REPLY BRIEF

In response to the Examiner's Answer dated June 7, Appellant's Reply Brief in accordance with 37 C.F.R. § 41.41 is hereby submitted.

Appellants are not aware of any fees due with this Reply Brief. However, any fee which is due in connection with this Reply Brief should be applied against Deposit Account No. 19-0522.

Respectfully submitted,

By


Jennifer C. Bailey, Reg. No. 52,583
Thomas B. Luebbering, Reg. No. 37,874
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, MO 64108
(816) 474-9050

ATTORNEYS FOR APPELLANTS

Argument

The Examiner argues that "with respect to claims 1, 17, and 22, it is noted that the claimed invention is directed to an isolation mechanism and not to an isolation mechanism in combination with a boom as argued by Appellant." Examiner's Answer, page 5. Appellants strongly disagree.

It should be noted that claims 1, 17, and 22 each recite a "boom" first in the preamble and then again in the body thereof. Appellants assert that "boom" is a claim limitation because it appears in both the preamble and the body. Appellants further assert that "boom" is a claim limitation when considered in the preamble alone.

First, the Federal Circuit has held that claim language is limiting in nature by virtue of its inclusion in both the preamble and the body of a claim. *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801 (Fed. Cir. 2002). In *Catalina Marketing*, the patented invention at issue was a system for dispensing coupons from various remote terminals that were connected to a central host computer system. *Id.* at 805. The invention was covered by U.S. Patent No. 4,674,041 (the '041 patent), of which independent claims 1 and 25 were at issue, and read as follows (with the disputed language underlined):

1. A system [sic] for controlling the selection and dispensing of product coupons at a plurality of remote terminals located at predesignated sites such as consumer stores wherein each terminal comprises:

activation means for activating such terminal for consumer transactions;
display means operatively connected with said activation means for displaying a plurality of coupons available for selection;
selection means operatively connected with said display means provided to permit selection of a desired displayed coupon by the consumer;
print means operatively connected with said selection means for printing and dispensing the coupon selected by the consumer; and
control means operatively connected with said display means for monitoring each consumer transaction and for controlling said display means to prevent the display of coupons having exceeded prescribed coupon limits.

25. A system for controlling the selection and dispensing of product coupons at a plurality of remote terminals located at predesignated sites such as consumer stores, comprising:

a plurality of free standing coupon display terminals located at predesignated sites such as consumer stores, each of said terminals being adapted for bidirectional data communication with a host central processing unit; each of said terminals comprising

- activation means for activating such terminals for consumer use by insertion of a credit card or other card having customer account information stored on a magnetic strip;
- display means operatively connected with said activation means for displaying a plurality of coupons;
- selection means operatively connected with said display means for providing for the selection of a desired displayed coupon by a consumer;
- print means operatively connected with said selection means for printing and dispensing the coupons selected;
- terminal control means operatively connected with said display means and print means for continuously monitoring each customer transaction and for controlling said display and print means in response to prescribed coupon limits;
- means for storing consumer transactions and for periodically communicating customer transactions to said host central processing unit;

said host central processing unit including means for transmitting to each terminal particular information for each coupon; and

said host central processing unit further including means for periodically transmitting to each terminal coupon limits such as and including expiration date, and total number of coupons to be dispensed.

Thus, both claim 1 and claim 25 recited the phrase "located at predesignated sites such as consumer stores" in the preamble, but only claim 25 recited the phrase in both the preamble and the body of the claim. Appellants note that this phrase, as used in the body of claim 25, appears in only a single element of the claim—the "plurality of . . . terminals"—and is used only to modify that element by reciting a location of the terminals.

The court in *Catalina Marketing* held that the phrase "located at predesignated sites such as consumer stores" was not a limitation in claim 1, because it appeared only in the preamble of that claim and there was no reason to construe the preamble of claim 1 as a limitation on that claim. *Id.* at 807–810. In contrast, the court held that the same phrase was a limitation in claim 25, explaining that

this language appears in both the preamble and the body of Claim 25. Hence, the applicants specifically included this language in the claim not

once, but twice. *By virtue of its inclusion in the body of Claim 25, this phrase limits Claim 25.*

Id. at 811 (emphasis added).

Appellants again emphasize that the language at issue in *Catalina Marketing* was not itself a positively recited element of claim 25, but rather modified an element (a "plurality of free standing coupon display terminals") by reciting a location of that element. Thus, even though the disputed claim language was found in only one of several claim elements, and only recited a location of that element, the court held that it was a limitation "by virtue of its inclusion in the body" of the claim.

Applying the principles of *Catalina Marketing* to the present case, one must conclude that the word "boom" as used in the application claims must be a claim limitation. The word "boom" appears in claim 1 not once, not twice (as in claim 25 of the '041 patent), but **seven times**—twice in the claim preamble and **five times** in the body of the claim. Similarly, "boom" is used four times in claim 17 (three times in the preamble and once in the body), and is used six times in claim 22 (once in the preamble, twice in a first element of the body, and three times in a second element of the body). Thus, the Examiner is ignoring clear Federal Circuit precedent by arguing (without providing legal grounds or reasoning) that "the claimed invention is directed to an isolation mechanism and not to an isolation mechanism in combination with a boom." Examiner's Answer, page 5.

Furthermore, even when considering the preamble of each of claims 1, 17, and 22 independently of the body of the claim, the word "boom" must be construed as limiting the claim scope.

As explained in the Appeal Brief, language in a claim preamble acts as a claim limitation when it serves to "give meaning to a claim and properly define the invention." Appeal Brief, March 13, 2006, pages 14–15. Each of the preambles of claims 1, 17, and 22 clearly serves to give meaning to its respective claim and to define the invention. In claim 1, for example, both "boom" and "control assembly" are first set forth in the preamble, and the first occurrence of each of these words in the body is preceded by "the" as opposed to "a." Similar usage of preamble terms is found in claims 17 and 22.

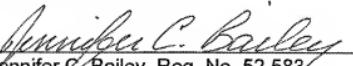
Furthermore, the court in *Catalina Marketing* listed an array of factors that weigh in favor of construing preamble language as a claim limitation. *Catalina Marketing*, 289 F.3d at 808–11. For example, the court said that “when reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation.” *Id.* (*citing Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)). The present application clearly underscores the importance of providing a dielectric gap between a control handle and a boom because, for example, the specification specifically identifies the prior art problem of booms that do not “protect against direct discharge via the electrically conductive structural material in the distal end of the boom, via the control valves, and via the control input mechanism, thereby leaving the worker vulnerable to damaging or deadly phase-to-phase or phase-to-ground electrical discharge along these paths.” Application, page 3, lines 7–12.

The court further stated that “dependence upon a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention.” *Id.* at 808 (*citing Bell Communications Research, Inc. v. VitaLink Communications Corp.*, 55 F.3d 615, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995)). As explained above, claims 1, 17, and 25 of the present invention all rely on at least one preamble phrase for antecedent basis.

For at least the reasons set forth above, each of claims 1, 17, and 22 must be construed such that “boom” is a limitation. Appellants further reassert all of the arguments set forth in the Appeal Brief. Accordingly, reversal of the Examiner’s rejections is proper, and such favorable action is solicited.

Respectfully submitted,

By


Jennifer C. Bailey, Reg. No. 52,583
Thomas B. Luebbering, Reg. No. 37,874
HOVEY WILLIAMS LLP
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